## REMARKS

This paper is responsive to the Final Office Action dated April 15, 2005. Claims 1 - 14 are pending in this application and claims 6 - 12 have been withdrawn from consideration. Claim 1 - 5 and 13 -14 have been rejected on the basis of prior art. Reconsideration of the Restriction Requirement and of the prior art rejection is respectfully requested.

These remarks follow the order of the Office Action beginning at page 2 thereof.

### Election/Restriction

Applicant respectfully traverses the Restriction Requirement first made on April 15, 2005. Claims 6 - 12 have been withdrawn from consideration as being directed to a non-elected invention. The additional limitations relate to the weight of a magnetic substance being at a predetermined ratio lower than that of the weight of the insulator. The Restriction Requirement recites 37 CFR § 1.142(b) and MPEP § 821.03. Applicant respectfully submits that the Examiner has not made the necessary statement of particular reasons relied upon by the Examiner for holding that the inventions claims are either independent or distinct. See MPEP § 816. It is further submitted that the Examiner has not followed the requirements of a letter of Restriction Requirement which relate to distinct inventions as set forth in MPEP § 817.

MPEP § 821.03 (cited by the Examiner) cites 37 CFR § 1.145 which relates to inventions distinct and independent from previously claimed inventions. The Examiner has not made such a finding. The Examiner has only stated, "not introduce previously". 37 CFR § 1.142(b) relates to claims to the invention not elected, if not canceled are nevertheless withdrawn from further consideration by the election. Applicant has not made such an election. The Examiner has imposed a Restriction Requirement which is herein traversed.

Applicant respectfully submits that the additional limitation found in claims 6 - 12 are fully supported by Applicant's specification paragraphs [0036] and [0037]. This is an additional limitation from the specification to the subject matter otherwise stated in claim 1 as originally filed upon filing of the Application. Since this Office Action has not stated the reasons for holding of independence or distinctness, there Restriction Requirement should be withdrawn.

## Claim Rejections - 35 USC §103

This rejection under 35 USC § 103 is newly presented in the Final Office Action because of amendment in the claims. The previous rejection based upon Saito '577 has been withdrawn. This is Applicant's first opportunity to comment on the new rejection of claims 1 - 5 and 13 - 14 as being unpatentable over Takaoka '092 in view of Sakata '087.

### Takaoka '092

Takaoka in Figure 2(right hand side) discloses a drum type magnetic core winding portion having two end flanges. A winding portion is shown between the two flanges and identified as "L". This is referred to as a choke coil. The shielding member S is formed by a method wherein a rubber composition material blended with magnetic powder is processed into a tube. The shielding member is mounted on the winding of the transformer T of the choke coil L. However, as shown in Figure 2 right-hand side, the shield S does not extend to the end flanges. The outer face side of the magnetic gap is not completely enclosed as set forth in Applicant's 1.

In Takaoka, there is no suggestion that the shield should completely enclose the coil L, and even as shown in Figure 2, left-hand side, the shielding member S does not provide magnetic shielding for the entire coil and transformer assembly. Therefore, this reference does not securely prevent magnetic fluxes from leaking around the wire which is a feature of Applicant's invention as stated in Applicant's specification [0032].

### Sakata

Sakata shows a magnetic core (2) which is square on the top and square on the bottom as shown in Figure 2. The coil wire winding (10) is around a magnetic core. The core (1) is made of a dielectric material such as a ceramic, and insulating material or magnetic material such a ferrite. The contact electrodes (6) and (7) are placed on the core. The entire assembly, as shown in Figure 2, is surrounded with a resin armor (15) which is made by molding or the like. Molding is necessary to form (15) because (15) must not only extend around the coil (10) it extends above the coil (10), and completely below the coil (10) even to cover the electrodes (6) and the contact (10a) and (10b).

Once the thermal plastic resin armor (15) is in place, a rubber-band type structure cannot stretch around and under the entire structure as shown in Figure 2.

Most importantly, the weld portions between the wire end (10a) and the electrode (6) and between the wire end (10b) and electrode (7) are covered and protected by resin armor (15) (see column 2, lines 30 - 35). Such a weld cannot be covered with a band as shown in Takaoka '092.

## The Rejection

This rejection requires removal of the resin armor (15) from Sakata and replacing it with a rubber material identified in Takaoka. However, this also destroys the purpose and function of resin armor (15) which is the protection of the electrodes (10a) and (10b) along with the structure which, as shown in Figure 2, extends down and under the coil and over the top of electrodes

(10a) and (10b). Replacement of the resin armor molding in Sakata with a rubber-band type, as taught in Takaoka, would result in no protection at all for the electrodes (10a) and (10b) of Sakata. The proposed modification cannot change the principle of operation of a reference, MPEP § 2143.02 and In re Ratti 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner states only that an insulator (15) of Sakata completely encloses the gap. However, the rejection does not explain why it would be obvious to remove the resin armor which also protects the solder points which is made by molding and replace it with a rubber-band type structure as taught by Takaoka. There is nothing in this rejection which points to teachings or suggestions in the references which would lead to Applicant's claimed invention as set forth in Claim 1.

In Sakata '087, the resin (15) cannot be removed from the core (1). Once the resin is in place (set), removal would necessarily result in destruction of the area around the contacts and even the coil itself because as shown in Figure 1, the resin impregnates the coil face. A substantial difference Applicant's invention and Sakata '087 is that Applicant provides a rubber magnetic gap filler which completely fills the gap and which can be removed. The outstanding Office Action does not point out or find any suggestion of this unique feature of Applicant's invention.

At page 3, line 15 the Examiner states that the specific method steps used to arrange/dispose the insulator into the magnetic gap would have been an obvious design consideration for the purpose of facilitating manufacturing. Applicant respectfully traverses this observation on the part of the Examiner because the Examiner has provided no teaching or suggestion in the prior art to support this assertion (see In re Sernaker 217 USPQ 1). Only Applicant's specification would teach this.

With respect to claim 4, Applicant has set forth that an insertion is integrally formed to be inserted into the magnetic gap. This can be seen in Applicant's Figure 2. This is not suggested by Sakata, who uses a resin armor formed by an injection molding. The resin armor cannot provide the functions set forth in claim 4 because it does not include the rubber elasticity (claim 1) which is necessary.

## Claim 13

The insertion tightly into the magnetic gap is not suggested by or found in either of the references. In Takaoka, the insulator does not even touch the flanges. On the other hand, in Sakata, the insulator is a resin which is poured to the flanges and this cannot suggest a tight insertion into a gap because the Sakata insulator is not compressible (rubber).

## Claim 14

This claim is not suggested by the references of record because neither reference has a rubber ring having a peripheral part extending from a peripheral part above an upper face of the flange. In Takaoka, there is no peripheral part of an upper flange. On the other hand, in Sakata, the insulator member (15) is not disclosed as rubber, and the references do not provide any suggestion or teaching that such a device should be rubber. Instead, Sakata is only a molding or the like. The molding is not a rubbery type material as disclosed in '087.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action in accordance thereof is requested. In the event there is any reason why the application cannot be allowed in this current condition, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems by Interview or Examiner's Amendment.

Respectfully submitted,

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